

tesa 685-HCL
101769-90
3162-SI-sti

REMARKS

Status of Claims

Claims 1 and 4-11 remain pending in the application. The only remaining issue outstanding is the rejection of the claims under 35 U.S.C. 103(a).

Waiver of Petition of Finality of Rejection

In the interest of compact prosecution, the applicants have not petitioned the finality of the rejection, however, it is unclear why:

- (1) the Examiner's Answer was not submitted; or
- (2) the Examiner's supervisor did not sign the final rejection.

(1) MPEP 1208.01 states that if "[t]here is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-1303, 190 USPQ 425, 426-7 (CCPA 1976)." If it was believed that there was no new grounds of rejection, the new reference could have been incorporated as part of his Examiner's Answer.

(2) Conversely, MPEP 1208.01 also states "37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer...The examiner **must obtain supervisory approval** in order to reopen prosecution after an appeal. See MPEP § 1002.02(d)." The new ground of rejection was not necessitated by applicants' amendment (see MPEP 706.07(a)) and the office action indicated that Mr. Terrell Morris was the SPE of the Art Unit at the time the action was signed.

35 U.S.C. 103(a) rejection

Claims 1 and 4-11 remain rejected by the examiner as being obvious over Kinzer et al. (U.S. Patent 5,667,893) individually or in view of Wiest et al. (U.S. Patent 4,322,516 – for claims 6 and 11) and Sobel (U.S. 3,609,190 - as evidence of the state of the art).

As the rejection has essentially remained unchanged, the applicants' stand by the arguments presented in the Appeal Brief, which for the sake of brevity will not be repeated here.

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Response to Arguments

Turning our attention to the comments in the previous office action, the fundamental basis for the applicants' arguments in the Appeal Brief was not that certain amines could not be hardeners but that to "pick and choose" this element from the teachings of Kinzer requires two enormous leaps of selectivity which is not taught by Kinzer, i.e. first to specifically choose a hardener as an additional ingredient and then to choose yet again that this hardener will be an amine. In this regard, the teaching of the Wiest et al. secondary reference does not remedy the deficiency of the Kinzer reference.

With respect to the arguments over whether Kinzer actually teaches a crosslinked epoxy resin, the examiner is reminded again about the impropriety of "picking and choosing" and failing to consider the reference as a whole.

The examiner wrote that "...Kinzer expressly teaches 'The formation of polymerized, crosslinked epoxy materials is well known. A variety of methods for polymerizing these species have been disclosed in the prior art, including polymerization of epoxy materials. The earliest reports of polymerization of epoxy materials relied upon thermal curing using, e.g. polyfunctional amine' (column 1, lines 19-24)".

However, the actual passage from col. 1, lines 19-24 of Kinzer is "The formation of polymerized, crosslinked epoxy materials structures using cationically sensitive species is well known. A variety of methods for polymerizing these species have been disclosed in the prior art, including polymerization of epoxy materials. The earliest reports of polymerization of epoxy materials relied upon thermal curing using, e.g. polyfunctional amine". - passage marked using PTO amendment rules

Moreover, even if this passage from Kinzer is taken at face value, this merely describes a general state of the prior art and not the invention of Kinzer itself. Inquiries of obviousness require consideration of the reference as a whole and Kinzer discloses these references to establish how his invention differs from the prior art (which is presumed to be true as the patent was granted) and that there were problems associated with the prior art inventions.

For the reasons cited above and the arguments made in the Appeal Brief, it is believed that the preponderance of evidence (see MPEP 2142) does not support a holding of *prima facie* obviousness and that the examiner would be justified in withdrawing this rejection.

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Miscellaneous Comments

While the applicants believe in the propriety of the arguments made above, in the interest of expedited prosecution, the applicants have informed the applicants' representative that claim 8 is of interest and would be willing to redraft the product claims into method claims dependent upon claim 8 if this would result in an allowance. The products claims can be re-prosecuted in a divisional application.¹

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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¹ It is presumed that the examiner has been made aware of the effects of the *Festo* series of decisions on patent prosecution. If there is an amendment the examiner would like the applicant(s) to make (especially to an independent claim), this must be expressed in the office action as applicant(s) are no longer afforded the luxury of "guessing" what the examiner would find allowable.

As a reminder of the reasons why this is so, selected passages from the recent *en banc* decision by the CAFC on *Festo* (26 September 2003) are provided below:

"...we reinstate those holdings of *Festo VI* that were not disturbed by the Supreme Court. To begin with, we recognize that the Court expressly endorsed our [Federal Circuit's] holding that a *narrowing amendment* made to comply with any provision of the Patent Act, *including §112, may invoke an estoppel....When the prosecution history reveals no reason for the narrowing amendment, Warner-Jenkinson presumes that the patentee had a substantial reason relating to patentability*, consequently, the patentee must show that the reason for the amendment was not one relating to patentability if it is to rebut that presumption...In this regard, we reinstate our earlier holding that a patentee's rebuttal of the *Warner-Jenkinson presumption is restricted to the evidence in the prosecution record.*" see *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, No. 95-1066 (Fed. Cir. Sept. 26, 2003), available at <http://www.fedcir.gov/opinions/95-1066c.doc>.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (5 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 8 October 2003

By: Agata Glinska
Agata Glinska